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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/058,788	DENDA ET AL.	
	Examiner	Art Unit	
	Leon J. Harper	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 April 2007*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/058,788
Filing Date: January 30, 2002
Appellant(s): DENDA ET AL.

Shreree T. Rowe
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/18/2007appealing from the Office action mailed 8/3/2006.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6711343	Matsumi et. al.	7-1998
6385152	Fujinami et. al	5-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumi et al. ('Matsumi hereinafter), USP 6,711,343 in view of Fujinami et al. ('Fujinamo' hereinafter), USP 6,385,152.

With respect to claim 1,

Matsumi discloses an information recording and reproducing apparatus for recording program information reproduced from an information recording medium or

program information supplied via a communication network into recording device (see col. 6, lines 2-10, Matsumi), said apparatus comprising:

a first recording unit, provided in said recording device, for recording said program information reproduced from the information recording medium or said program information supplied via the communication network (see col. 6, lines 6-10, Matsumi);

and control means for, when said program information is recorded into said first recording unit (a control means for controlling said recording/reproducing means in accordance with said command signals or said operation signal, see col. 7, lines 46-50, Matsumi), (a) obtaining management information for managing said program information recorded in the information recording medium or supplied via the communication network (see col. 27, lines 17-29, Matsumi), (b) in case that the title information corresponding to said program information is obtained by searching (see col. 25, lines 6-10, Matsumi) through said second recording unit based on the management information obtained, appending (by recording file system information B having the data having already been recorded and the append-recorded data, a normal condition can be restored, see col. 27, lines 30-32 and lines 59-61, Matsumi) the title information obtained to said program information so as to be recorded into said first recording unit (see col. 27, lines 30-34, Matsumi), and (c) in case that the title information corresponding to said program information is not obtained by searching

through said second recording unit based on the management information obtained, appending information indicating an absence (the file system information A is recorded in data having already been recorded. The same file system information A is recorded twice, and the information title end indicating the end position of the program is set so as to indicate the recording end position of the entry of first file system information and then recorded. The file system information A is recorded in two adjacent areas; an address indicating the position between the two areas is recorded at the predetermined position of the tape 110 or on the additional recording medium 113. After recording is carried out, if additional recording is carried out by a conventional apparatus not conforming to the file system information, the file system information A recorded at the second time is not recognized, data is recorded from the information title end indicating the end position of the program, and the file system information A recorded at the second time is deleted completely. In this condition, an abnormal condition can be recognized because two pieces of the file system information A are not present, and file restructuring can be carried out without problems hereafter because the file system information A itself regarding filed data having already been recorded remains. By recording the file system information B having the data having already been recorded and the append-recorded data the normal condition can be restored, see col. 27, lines 35-61, Matsumi) of the title information to said program information so as to be recorded into said first recording unit (see col. 28, lines 19-22, Matsumi),

wherein the second recording unit is provided in said recording device, for recording title information corresponding to said program information prior to recording said program information (see col. 27, lines 17-26, Fig. 12(a), Matsumi);

wherein said title information comprises at least one of disc title, the name of a artist, genre, the year of sale of disc track title and the artist(s) for respective track(s) (see Fig. 32).

Matsumi does not explicitly indicate the claimed "communication network".

Fujinami discloses claimed communication network (as presentation media for presenting a computer program to be executed for carrying out the processing to the user, communication media network and a satellite can be used in addition to a magnetic disc, a CD-ROM and a recording medium such as solid-state memory, see col. 24, lines 45-50, Fujinami).

It would have been obvious to one ordinary skill in the recording media processing art at the time of the present invention to combine the teachings of the cited references because the communication network of Fujinami's teachings would have allowed Matsumi's system in the recording/playback environment to capable of recording data distinguishing overwrite recording from append recording as suggested

by Fujinamo at col. 1, lines 11-14. Communication network as taught by Fujinamo improves to judge the indication of append-recording (see col. 1, lines 50-51, Fujinamo).

As to claim 2,

Matsumi teaches wherein, when updated title information is supplied by way of an information recording medium or via the communication network, said control means records said updated title information into said second recording unit, and searches through said second recording unit (after updating) for the title information corresponding to said program information appended with the information indicating the absence of the title information, and when the title information corresponding to said program information is obtained, said control means appends the title information obtained to said program information so as to be recorded into said first recording unit (see col. 27, lines 21-29 and col. 28, lines 19-22, Matsumi).

As to claim 3,

Matsumi teaches wherein said control means searches through said second recording unit after updating, based on the management information for managing said program information appended with the information indicating the absence of the title information (see col. 34, lines 48-50, Matsumi).

As to claim 4,

Matsumi teaches further comprising one of the followings: reproducing means for reproducing the information recording medium having recorded the updated title information (see col. 27, lines 50 to col. 28, lines 2, Matsumi); and receiving means for receiving the updated title information supplied via the communication network (see col. 20, lines 63-66, Matsumi).

With respect to claim 5,

Matsumi discloses a method of appending title information for appending title information to program information reproduced from an information recording medium or program information supplied via a communication network so as to be recorded into recording device (see col. 6, lines 2-10, Matsumi), said method comprising: the step of recording said program information reproduced from the information recording medium or said program information supplied via the communication network into a first recording unit provided in said recording device (see col. 6, lines 6-10, Matsumi);

the step of, when said program information is recorded into said first recording unit, obtaining management information for managing said program information recorded in the information recording medium or supplied via the communication network, and, based on the management information obtained, searching through a second recording unit equipped in said recording device provided for recording title information corresponding to said program information prior to recording said program information (see col. 27, lines 17-26, Fig. 12(a), Matsumi); and

the step of appending the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is obtained in said step of searching (see col. 25, lines 6-10, Matsumi), and appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is not obtained in said step of searching (see col. 28, lines 19-22 et seq, Matsumi).

wherein said title information comprises at least one of disc title, the name of a artist, genre, the year of sale of disc track title and the artist(s) for respective track(s) (see Fig. 32).

Matsumi does not explicitly indicate the claimed "communication network".

Fujinami discloses claimed communication network (as presentation media for presenting a computer program to be executed for carrying out the processing to the user, communication media network and a satellite can be used in addition to a magnetic disc, a CD-ROM and a recording medium such as solid-state memory, see col. 24, lines 45-50, Fujinami).

It would have been obvious to one ordinary skill in the recording media processing art at the time of the present invention to combine the teachings of the cited references because the communication network of Fujinami's teachings would have

allowed Matsumi's system in the recording/playback environment to capable of recording data distinguishing overwrite recording from append recording as suggested by Fujinamo at col. 1, lines 11-14. Communication network as taught by Fujinamo improves to judge the indication of append-recording (see col. 1, lines 50-51, Fujinamo).

As to claim 6,

Matsumi teaches the step of obtaining updated title information when the updated title information is supplied by way of an information recording medium or via the communication network (see col. 27, lines 21-29 and col. 28, lines 19-22, Matsumi);

the step of recording the updated title information obtained into said second recording unit, and searching through said second recording unit (after updating) for the title information corresponding to said program information appended with the information indicating the absence of the title information (see col. 28, lines 19-22, Matsumi); and

the step of appending the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is obtained by searching through said second recording unit after updating (see col. 27, lines 21-29 and col. 28, lines 19-22, Matsumi).

As to claim 7,

Matsumi teaches wherein, in said step of searching through said second recording unit after updating, said second recording unit after updating is searched through based on the management information for managing said program information appended with the information indicating the absence of the title information (see col. 28, lines 19-22, Matsumi).

With respect to claim 8,

Matsumi discloses a program recording medium having recorded a title information appending procedure program for allowing a computer to execute a process to append title information to program information reproduced from an information recording medium or program information supplied via a communication network so as to be recorded into recording device (see col. 6, lines 2-10, Matsumi), the title information appending procedure comprising:

the procedural step of recording said program information reproduced from the information recording medium or said program information supplied via the communication network into a first recording unit provided in said recording device (see col. 6, lines 6-10, Matsumi);

the procedural step of, when said program information is recorded into said first recording unit, obtaining management information for managing said program

information recorded in the information recording medium or supplied via the communication network, and, based on the management information obtained, searching through a second recording unit equipped in said recording device provided for pre-recording the title information corresponding to said program information (see col. 27, lines 17-26, Fig. 12(a), Matsumi); and

the procedural step of appending the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is obtained in said procedural step of searching, and appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is not obtained in said procedural step of searching (see col. 28, lines 19-22, Matsumi). wherein said title information comprises at least one of disc title, the name of a artist, genre, the year of sale of disc track title and the artist(s) for respective track(s) (see Fig. 32).

Matsumi does not explicitly indicate the claimed "communication network".

Fujinami discloses claimed communication network (as presentation media for presenting a computer program to be executed for carrying out the processing to the user, communication media network and a satellite can be used in addition to a magnetic disc, a CD-ROM and a recording medium such as solid-state memory, see col. 24, lines 45-50, Fujinami).

It would have been obvious to one ordinary skill in the recording media processing art at the time of the present invention to combine the teachings of the cited references because the communication network of Fujinami's teachings would have allowed Matsumi's system in the recording/playback environment to capable of recording data distinguishing overwrite recording from append recording as suggested by Fujinamo at col. 1, lines 11-14. Communication network as taught by Fujinamo improves to judge the indication of append-recording (see col. 1, lines 50-51, Fujinamo).

As to claim 9,

Matsumi teachesthe procedural step of obtaining updated title information when the updated title information is supplied by way of an information recording medium or via the communication network (see col. 27, lines 21-29 and col. 28, lines 19-22, Matsumi);

the procedural step of recording the updated title information obtained into said second recording unit, and searching through said second recording unit after updating for the title information corresponding to said program information appended with the information indicating the absence of the title information (see col. 28, lines 19-22, Matsumi); and

the procedural step of appending the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is obtained by searching through said second recording unit after updating (see col. 27, lines 21-29 and col. 28, lines 19-22, Matsumi).

As to claim 10,

Matsumi teaches wherein said procedural step of searching through said second recording unit after updating includes the procedural step of searching through said second recording unit (after updating) based on the management information for managing said program information appended with the information indicating the absence of the title information (see col. 28, lines 19-22 et seq, Matsumi).

(10) Response to Argument

This Examiner's answer will address the arguments in the order in which they appear in the appeal brief.

Argument (1): Matsumi does not disclose (b) in case that the title information corresponding to the program information is obtained by searching through a second recording unit based on management information obtained, appending the title information obtained to said program information so as to be recorded into the first recording unit. The section of Matsumi referenced as teaching (b) merely describes

recording a start and stop position and file system information on a recording medium (See column 25, lines 6-10).

In response to argument (1) Examiner respectfully submits appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit,and Matsumi teaches this limitation as, the file system information A is recorded in data having already been recorded. The same file system information A is recorded twice, and the information title end indicating the end position of the program is set so as to indicate the recording end position of the entry of first file system information and then recorded. The file system information A is recorded in two adjacent areas; an address indicating the position between the two areas is recorded at the predetermined position of the tape 110 or on the additional recording medium 113.

Argument (2): Matsumi does not disclose (c) in case that the title information is not obtained by searching through said second recording unit based on the management information obtained, appending information indicating an absence of the title information to said program information so as to be recorded into the first recording unit. The section of Matsumi referenced as teaching (c) describes the situation wherein an additional recording is carried out in an apparatus that does not conform to Matsumrs apparatus. In this situation, previously recorded file system information A will not be recognized and will be recorded over so that information A is

deleted. (See column 27, lines 16-29 and Figure 12 (b) showing the appended recorded data recorded over the previous information A as shown in Figure 12(a)). This causes the recorded data to be in an unfiled condition for Matsumi's apparatus. Thus, the data must have file system data B recorded in order to have the normal condition restored.

In response to Argument (2) Examiner respectfully submits that Matsumi teaches this limitation as a control means for controlling said recording/reproducing means in accordance with said command signals or said operation signal, see col. 7, lines 46-50, Matsumi.

Argument (3): Furthermore, Matsumi does not teach the recording apparatus including a second recording unit provided in the recording device for recording title information corresponding to the program information prior to recording the program information. The Examiner again cites the section of Matsumi that teaches a second, nonconforming recording device recording over the previous file system information A because it is a separate device that does not recognize information A.

In response to argument (3) Examiner respectfully submits that the limitation recording apparatus including a second recording unit provided in the recording device for recording title information corresponding to the program information prior to recording the program information is taught in Matsumi col. 27, lines 17-26, Fig. 12(a).

Argument (4): The Examiner also asserts that Matsumi teaches the function of searching through the second recording unit for the title information and refers to Col. 25, lines 6- 10 and Col. 27, lines 30-34 of Matsumi. However, a closer examination of Matsumi reveals that Matsumi merely teaches searching the file system information A or B, as indicated in Figs. 6, 7, 12C, 16B and 17, and the title information found in the search is not appended to the program information (Col. 24, lines 4-10). Matsumi merely teaches appending a valid file system information after the last program or data file is recorded. There is no teaching or suggestion in Matsumi that the title information is appended to each individual data file, as recited in independent claims 1, 5 and 8.

In response to argument (4) examiner respectfully submits that Matsumi discloses that information is also recorded on a second medium or recording unit (See Matsumi column 25 lines 5-10). Allowing searching to be done on a secondary unit allows for the information on the first recording unit to be confirmed easily (See column 25 lines 7-13).

Argument (5): Additionally, the Examiner alleges that Matsumi teaches that the title information includes at least one of disc title, the name of an artist, genre, the year of sale of the disc, track title and the artist for respective tracks, and points to Fig. 32 (December 16, 2005 Office Action, page 5, lines 9-11). However, a closer examination of Matsumi and, specifically, Fig. 32, reveals that Fig. 32 is a block diagram showing the configuration of a computer that includes a processor 251, a memory 252,

a bus 253, several interfaces 254 and 255, a hard disk 257, a reception command 263, and a writing command 264 (Col. 42, lines 24-36).

In response to argument (5) examiner respectfully submits that Matsumi teaches that the title information includes at least one of disc title, the name of an artist, genre, the year of sale of the disc, track title and the artist for respective tracks. in Fig. 32.

Argument (6): respectively. In addition to the arguments listed above, the Appellants submit that, contrary to the Examiner's assertion, Matsumi in view of Fujinamo fail to teach or suggest when updated title information is supplied, recording the updated title information into the second recording unit, searching through the second recording unit (after updating) for the title information corresponding to the program information appended with the information indicating the absence of the title information, and when the title information corresponding to the program information is obtained, appending the title information obtained to said program information so as to be recorded into said first recording unit, as recited in claims 2-4, 6-7, and 9-10. The referenced section of Matsumi merely teaches the situation wherein an additional recording is carried out in an apparatus that does not conform to Matsumi's apparatus. In this situation, previously recorded file system information A will not be recognized and will be recorded over so that information A is deleted. (See column 27, lines 16-29 and Figure 12 (b) showing the appended recorded data recorded over the previous

information A as shown in Figure 12(a)). This causes the recorded data to be in an unfiled condition for Matsumi's apparatus. Thus, the data must have file system data B recorded in order to have the normal condition restored.

In response to argument (6) examiner respectfully submits that During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). Reasons why Matsumi discloses recording to a second medium does not nonetheless negate the disclosure. Matsumi discloses updated title information is supplied, recording the updated title information into the second recording unit, searching through the second recording unit (after updating) for the title information corresponding to the program information appended with the information indicating the absence of the title information, and when the title information corresponding to the program information is obtained, appending the title information obtained to said program information so as to be recorded into said first recording unit see col. 27, lines 21-29 and col. 28, lines 19-22, Matsumi.

Argument (7): In order to establish a prima facie case of obviousness, there must be some reason to modify the reference or combine reference teachings. The Examiner asserts that one of ordinary skill in the art would combine the communication network of Fujinamo with the apparatus of Matsumi in order to allow Matsumi's system to distinguish overwrite recording from append recording.

In response to argument (7) examiner respectfully submits that the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071,5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Matsumi does not explicitly indicate the claimed "communication network". Fujinami remedy such kinds of deficiency by teaching as presentation media for presenting a computer program to be executed for carrying out the processing to the user, communication media network and a satellite can be used in addition to a magnetic disc, a CD-ROM and a recording medium such as solid-state memory, see col. 24, lines 45-50, Fujinami). It would have been obvious to one ordinary skill in the recording media processing art at the time of the present invention to combine the teachings of the cited references because the communication network of Fujinami's teachings would have allowed Matsumi's system in the recording/playback environment to capable of recording data distinguishing overwrite recording from append recording as suggested by Fujinamo at col. 1, lines 11- 14. Communication network as taught by Fujinamo improves to judge the indication of append-recording (see col. 1, lines 50-51, Fujinamo).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conslusion

Claims 1-10 are properly rejected under 35 U.S.C. §103(a). In light of the foregoing arguments, the Examiner respectfully request that the Honorable Board of Appeals sustain the rejections.

Respectfully submitted,

Leon J. Harper LJH
Patent Examiner
Art Unit 2166

Conferees
1. Hosain Alam, Supervisory Primary Examiner, Art Unit 2166
2. Mohammad Ali ,Supervisory Primary Examiner Art Unit 2165

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